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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,721

10/01/2007

Steffen Schmalz

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EXAMINER

BITAR, NANCY

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,721	<b>Applicant(s)</b> SCHMALZ ET AL.	
	<b>Examiner</b> NANCY BITAR	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/23/08, 2/11/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Examiner Notes**

1. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) **1-5** are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

NOTE: Regarding the rejection of claims 1-5, please see the Memorandum dated May 15, 2008, "Clarification of Processes under 35 USC § 101" which may be viewed at the following web address:

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section101\\_05\\_15\\_2008.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section101_05_15_2008.pdf)

### ***Drawings***

3. The drawings are objected to because figure 1 does not comply with 37 CFR 1.84(o) where suitable descriptive legends may be used subject to approval by Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3,5- 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al ( US 2003/0132281) in view of Sansone et al ( Signature verification, increasing performance by a multi stage system)

As to claims 1-3, Jones et al teaches the method for recognizing forged bank notes, wherein the bank notes to be checked are compared with comparative data, which are derived from authentic bank notes and known forgeries ( see applicant admitted preamble, specification paragraph [0004]) ,comprising the steps using additional comparative data for new types of

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forgeries, wherein the bank notes to be checked are compared with both the comparative data and the additional comparative data for new types of forgeries so as to determine whether a forged bank note is present (see figure 16; adapted to receive a plurality of currency bills and an image scanner adapted to obtain an image of a currency bill and to extract a serial number from the image of the currency bill. An authentication and discrimination unit is also included to perform counterfeit testing on the currency bill. Coupled to the input receptacle is a transport mechanism adapted to transport each of the currency bills one at a time from the input receptacle past the image scanner and the authentication and discrimination unit to at least one output receptacle. A memory storage is adapted to store the obtained image of each of the currency bills. The memory is also adapted to store at least one serial number of counterfeit currency bills. A controller is adapted to update the memory with a serial number of a currency bill determined to be counterfeit by the authentication and discrimination unit, paragraph [0183-0185]. While Jones meets a number of the limitations of the claimed invention, as pointed out more fully above, Jones fails to specifically teach that only a comparison with the additional comparative data for new types of forgeries is effected, if with the check with the help of the comparative data the authenticity of the bank notes to be checked has been determined and if for the determined kind of bank notes comparative data for new types of forgeries are available.

Specifically, Sansone et al. teaches the use of a decision process where a random and simple forgeries can be very different from genuine signatures, because in both cases the writer does not know the model of the genuine signature, it seems reasonable to consider random and simple forgeries as one category. Consequently, the system is made up of three stages: the first will cope with random and simple forgeries; the second with skilled forgeries; while the final

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stage intervenes only if the two previous stages were unable to make a decision. An overview of the overall system is given in Fig. 2(a-b), page 171. Moreover, Sansone et al teaches The recognition process starts by presenting the input signature to the first stage. If its response is that the signature is a forgery and the reliability associated with this decision is higher than a suitably fixed reliability threshold, the system concludes that the signature is a forgery and the process stops. Because the practice of carrying out further authenticity checks only when previous checks have revealed an authenticity assumption as taught by Sansone. It would have been obvious to one of ordinary skill in the art to use the decision process in Jones in order to prevent fraud and the circulation of counterfeit money. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention by applicant.

As to claim 5, Jones et al teaches the method according to claim 1, wherein the additional comparative data ( serial numbers, paragraph [0183]) for new types of forgeries are derived and produced from the new type of forgery after the first occurrence of the new type of forgery ( paragraph [0183-0185]) .

6. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al ( US 2003/0132281) in view of Pernot et al ( EP 1255232).

While Jones meets a number of the limitations of the claimed invention, as pointed out more fully above, Jones fails to specifically teach the comparative data and additional comparative data for new types of forgeries are available for each possible position of the bank notes.

Specifically, Pernot et al. teaches the four different positions of introducing the bank note where the acceptance of banknote by authenticity checking machines in all possible positions of the

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banknote (paragraph [0051]). It would have been obvious to one of ordinary skill in the art to (authenticate the bank note is different position in order the new type of forgery can be effected independently of the respective position .Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention by applicant.

Claims 6-7 differ from claim 1-3 only in that claim 1-3 are method claims whereas, claim 6-7 are an apparatus claim. Thus, claims 6-7 are analyzed as previously discussed with respect to claims above.

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY BITAR whose telephone number is (571)270-1041. The examiner can normally be reached on Mon-Fri (7:30a.m. to 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinge Wu can be reached on 571-272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Jingge Wu/  
Supervisory Patent Examiner, Art Unit 2624

Nancy Bitar

12/18/2008